

REMARKS

Claims 1-55 are pending in the present application. New claims 64-88 are added above. No new matter is added by the new claims. Entry is respectfully requested.

The applicants note, with appreciation, that the Office Action indicates at page 6, section 9, that claims 11-22 and 39-49 would be allowable if rewritten in independent form. Accordingly, new claim 64 is added to incorporate the limitations of independent claim 1 and dependent claim 11. New claims 65-67 include the limitations of dependent claims 12-14. New claim 68 is added to incorporate the limitations of independent claim 1 and dependent claim 15. New claims 69-75 include the limitations of dependent claims 16-22. New claim 76 is added to incorporate the limitations of independent claim 29 and dependent claim 39. New claims 77-78 include the limitations of dependent claims 40-41. New claim 79 is added to incorporate the limitations of independent claim 29 and dependent claim 42. New claims 80-86 include the limitations of dependent claims 43-49. Entry and allowance of claims 64-86 is respectfully requested.

Claims 1, 2, 7, 8, 9, 10, 23-27, 29, 30, 35, 36, 37, 38 and 50-54 stand rejected under 35 U.S.C. 102(e) as being anticipated by Selinfreund, *et al.* (U.S. Publication Number 2005/0050343 - hereinafter "Selinfreund '343"). Claims 3-6, 28, 31-34 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selinfreund '343. Reconsideration of the rejection and allowance of claims 1-55 are respectfully requested.

Selinfreund '343 was filed on August 21, 2003 as U.S. Serial No. 10/645,078, and is a continuation-in-part of U.S. Serial No. 09/631,585, filed on August 3, 2000 (hereinafter "Selinfreund '585"). Selinfreund '585 is, in turn, a continuation-in-part application of U.S. Serial No. 09/608,886, filed on June 30, 2000 and is now abandoned (hereinafter "Selinfreund '886").

The present application was filed on December 12, 2004, as U.S. Serial No. 10/023,424, and claims the benefit of U.S. Provisional Application Serial No. 60/255,653, filed December 14,

2000.

The Selinfreund '343 publication includes newly added subject matter that was introduced to the specification and claims of the application filed on August 21, 2003. The following paragraphs contain such newly added subject matter: [0009], portions of [0010], [0012], [0018], portions of [0020], [0030]-[0038], portions of [0060], [0085], and [0086].

It is submitted that the newly added subject matter of Selinfreund '343 is not available as prior art against the present application under 102(e) or 103(a)/102(e), since the effective date of invention of the present application, namely the filing date of December 12, 2001, precedes the filing date of Selinfreund '343, August 21, 2003. Therefore, it is submitted that Selinfreund '343 is not available as a prior art reference against the present application with regard to the newly added subject matter.

The prior subject matter of the Selinfreund '343 reference that was repeated from the Selinfreund '585 and Selinfreund '886 references, however, may be considered to arguably be available as prior art against the present application under 102(e) or 103(a)/102(e). The Applicant therefore responds to the outstanding rejection on the basis of such prior subject matter, and its potential applicability as prior art, either through the present publication of the Selinfreund '343 reference, or by the potential issuance of the Selinfreund '585 reference as a patent.

The applicants note that the 1449 documents included with the Office Action dated March 1, 2006 indicated that the Examiner did not consider the prosecution histories for Selinfreund '886 and Selinfreund '585 labeled as references AS and AT, respectively, of the Information Disclosure Statement mailed on December 6, 2005. The applicants note that, while Selinfreund '886 and Selinfreund '585 have not been published as patent publications, the prosecution histories of Selinfreund '886 and Selinfreund '585 are available on the USPTO Patent Application Information Retrieval (PAIR) web site because Selinfreund '343 claims priority to these applications. Accordingly, an Information Disclosure Statement is filed

herewith with copies of the specifications and drawings for Selinfreund '886 and Selinfreund '585 since this information may be considered to be available as prior art subject matter against the present application through the present publication of the Selinfreund '343 reference.

The present invention as claimed in independent claim 1 is directed to a method for modifying an optical path of an optical medium. The optical medium includes a first layer adjacent a data layer. The method includes selecting a region of the first layer to be distorted. Further, prior to a reading operation of the medium, the region of the first layer is distorted such that a reading operation of data stored in the data layer corresponding to the distorted region is modified. The distorted region extends in a direction along a track of the data layer. The distorted region maintains its optical characteristics following irradiation of the distorted regions during the reading operation.

The present invention as claimed in independent claim 29 is directed to an optical medium. The optical medium has a modified optical path. The optical medium includes a first layer adjacent a data layer. Further, the optical medium includes a distorted region that is formed at the first layer prior to a reading operation of the medium, such that a reading operation of data stored in the first layer corresponding to the distorted region is modified. The distorted region extends in a direction along a track of the data layer. The distorted region maintains its optical characteristics following irradiation of the distorted regions during the reading operation.

Thus, in the invention as claimed in claim 1 and in the invention as claimed in claim 29, the distorted region has associated with it certain "optical characteristics" following its formation, that are "maintain(ed)", and are therefore stable. This stability is maintained, even "following irradiation of the distorted region" during a subsequent "reading operation".

The subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 discloses applying a light sensitive material to a CD which alters between two optical states, for example between transparent and light emitting, invisible and visible, light transmissive and light absorbing, and light emitting and non-emitting, by being illuminated, such as by a laser light

from a CD reader (see Selinfreund '343, paragraph [0041]). In certain embodiments, the light sensitive material may optionally have some delay time between being illuminated and actually changing from the first to second optical state so that data may be read from the CD before the light sensitive material changes to the second optical state.

The subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 fails to teach or suggest "the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation", as claimed in independent claims 1 and 29. Instead, in the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886, the light sensitive material changes from a first optical state to a second optical state upon being illuminated during a read operation, and therefore the optical characteristics are not maintained. In the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886, when there is a delay time between being illuminated and actually changing optical state, the irradiation of the light sensitive material during the reading operation still causes the light sensitive material to eventually change between a first optical state and a second optical state, it is just delayed. Therefore, in the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 the optical characteristics are not maintained in the regions of the medium where the light sensitive material is applied.

With regard to the rejections of claims 3-6 and 31-34, referring to the Office Action at page 5, section 8, if the light sensitive material disclosed by the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 were applied to a back layer of a medium as asserted, this would not make an impact on the optical path, as the light sensitive material would be located behind the data layer relative to the reading laser. The light sensitive material of the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 would therefore have no effect on the data being read when positioned on the back layer, since the back layer is shielded by the reflective material of the data layer. Therefore, placing the light sensitive material described in the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 on the back layer of a medium would not render the present invention as claimed in claims 3-6 and 31-34 obvious.

It is therefore submitted that independent claims 1 and 29 are allowable over the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886. Reconsideration of the rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Selinfreund '343, and allowance of the claims, are respectfully requested. With regard to the rejection of dependent claims 2, 7, 8, 9, 10, 23-27, 30, 35, 36, 37, 38 and 50-54 as being anticipated by Selinfreund '343, it follows that these claims should inherit the allowability of the independent claims from which they depend. Further, reconsideration of the rejection of dependent claims 3-6, 28, 31-34 and 55 under 35 U.S.C. 103(a) as being unpatentable over Selinfreund '343, and allowance of the claims, are respectfully requested, since these claims should inherit the allowability of the independent claims from which they depend.

With regard to the newly added claims 87 and 88, the subject matter of Selinfreund '343 taken from Selinfreund '585 and Selinfreund '886 fails to teach or suggest a method comprising "prior to a reading operation of the medium, distorting the region of the first layer by applying a permanent physical distortion to the medium in the first layer, to provide a distorted region in the first layer that modifies the optical path of the medium, such that a reading operation of data stored in the data layer corresponding to the distorted region is modified, the distorted region extending in a direction along a track of the data layer, the distorted region having permanent optical characteristics as a result of the physical distortions that are maintained following irradiation of the distorted region during the reading operation" as claimed in independent claim 87, and an "optical medium" comprising "a distorted region formed at the first layer prior to a reading operation of the medium by applying a permanent physical distortion to the medium in the first layer, to provide a distorted region in the first layer that modifies the optical path of the medium such that a reading operation of data stored in the data layer corresponding to the distorted region is modified, the distorted region extending in a direction along a track of the data layer, the distorted region having permanent optical characteristics as a result of the physical distortion that are maintained following irradiation of the distorted region during the reading operation", as claimed in independent claim 88. Instead, the subject matter of Selinfreund '343

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taken from Selinfreund '585 and Selinfreund '886 discloses application of a light sensitive material that does not have permanent optical characteristics, but rather, optical characteristics that change after being illuminated, for example, during a read operation. Allowance of independent claims 87 and 88 is respectfully requested.

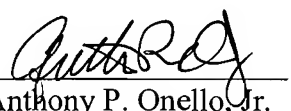
Closing Remarks

It is submitted that all claims are in condition for allowance, and such allowance is respectfully requested. If prosecution of the application can be expedited by a telephone conference, the Examiner is invited to call the undersigned at the number given below.

Authorization is hereby given to charge Deposit Account No. 501798 for any additional fees which may be due or to credit any overpayment.

Respectfully submitted,

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